UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,757	12/30/2003	Nikolai G. Nikolov	6570P037	9105

45062   7590   03/23/2010
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EXAMINER
RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
2192	

MAIL DATE	DELIVERY MODE
03/23/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/749,757	NIKOLOV, NIKOLAI G.
	Examiner	Art Unit	
	JAMES RUTTEN	2192	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 December 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>40-54</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>40-54</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>10/17/09</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is in response to Applicant's submission filed 12/18/2009, responding to the

9/17/2009 Office action which detailed the rejection of claims 40-54. Claims 40-41, 45-46, and

50-51 have been amended. Claims 40-54 remain pending in the application and have been fully

considered by the examiner.

Response to Arguments/Amendments

2.   Applicant's amendments of claims 41, 46, and 51, with respect to the rejections and

arguments under 35 U.S.C. § 112, second paragraph are persuasive. Likewise, the rejection is

withdrawn.

3.   Applicant's arguments filed 12/18/2009 have been fully considered but they are not

persuasive. On pages 7-9, Applicant essentially argues that the combination of prior art of record

Berry and Ims teach that "all classfiles within an archive file received from a network are

modified but less than all of the methods within these classfiles need to be modified," in contrast

to the claims which recite "modifying bytecode of only one classfile within any one of [the]

archive files" where "[the] archive files [have] respective classfiles." In support of the argument,

Applicant cites various portions, including Berry column 5 lines 16-20: "The Java Runtime is

modified, using the method of the present invention so that it provides functionality to modify all

class files that the Runtime loads across the network for subsequent execution." Applicant also

provides the following citation at Berry column 7 lines 5-11: "Selective instrumentation is

possible if only some of the methods are to be instrumented. In the described embodiment, an

inclusion/exclusion list is used to specify which methods are to be instrumented." The cited

portions show that Berry discloses modification of methods that appear in an inclusion list,

where the methods are present in a loaded classfile. If a single method is listed in the inclusion

list, while all other methods are provided in the exclusion list, only the single method in a single

classfile is modified. While the cited portions do not provide extensive details regarding the

available permutations of methods and classfiles that could be modified through use of the

inclusion/exclusion lists, Berry provides implicit support for modification of a single method

among one or more classfiles. In other words, the inclusion/exclusion lists provide for the

modification of all methods, the modification of none of the methods, and everything in-

between; including the modification of only one method, which necessarily involves only one

classfile. Furthermore, column 8, lines 29-34 describes the process of Fig. 7 for injecting hooks

in "a method" of "a class file." This passage could be interpreted as providing explicit support

for "modifying bytecode of only one classfile" and of "only one method" as claimed.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 40-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

No. 6,662,359 (Berry et al.) in view of U.S. Patent No. 6,560,618 (Ims).

Regarding claim 40, *Berry et al.* discloses a method comprising reading program code from memory and processing said program code with one or more processors to perform the following:

providing a user with options for modifying an application's bytecode, said application composed of class files, said class files having respective methods, said options including one or more of the following:

      i) modifying bytecode of only one classfile;

      ii) modifying bytecode of only one method within only one of the [application's] respective classfiles (*see, e.g., Berry et al.* at col. 5, line 59, through col. 6, lines 45; col. 7, lines 5-11 (selective instrumentation of some or all methods); Furthermore, see column 8 lines 29-34 with respect to Fig. 7);

modifying bytecode of said application in accordance with said user's selection of one of said options (*see, e.g., Berry et al.* at col. 5, line 59, through col. 6, lines 45; col. 6, line 51, through col. 7, line 17);

executing said application in an object oriented runtime frame work, said executing including processing a portion of said application's bytecode that was modified in accordance with said user's selection of one or more of said options (*see, e.g., Berry et al.* at col. 7, lines 44-45); and,

presenting to said user an output generated from execution of said portion of said application's bytecode that was modified (*see, e.g., Berry et al.* at col. 6, lines 55-65).

Berry et al. fails to expressly disclose said application composed of a plurality of archive files, said archive files having respective class files. However, *Ims* teaches that it has been

known for JAVA applications (like those modified by *Berry*) to be arranged into archive files to ensure that all required files and classes are available (see, e.g., *Ims* at col. 2, lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize archive files as a known means of organizing JAVA applications.

Regarding claim 41, *Berry et al.* further discloses said object oriented runtime framework being a JAVA compliant object oriented runtime framework (*see, e.g., Berry et al.* at col. 4, lines 22-29).

Regarding claim 42, *Berry et al.* further discloses said application's bytecode that was modified including a method entry or method exit (*see, e.g., Berry et al.* at col. 6, line 51, through col. 7, line 17).

Regarding claim 43, *Berry et al.* further discloses said output being provided by a plug-in that a bytecode instruction inserted at said method entry or method exit is dispatched to (*see, e.g., Berry et al.* at col. 6, line 51, through col. 7, line 17).

Regarding claim 44, *Berry et al.* further discloses said output including one of: a time at which said method entry or method exit was entered; and, a parameter that is passed at said method entry or method exit (*see, e.g., Berry et al.* at col. 6, lines 1-16; col. 6, line 51, through col. 7, line 17).

Regarding claims 45-49, these are machine-readable storage medium versions of the claimed methods discussed above (claims 40-44). *Berry et al.* further discloses the use of such media to implement the prescribed methods (*see, e.g., Berry et al.* at col. 14, lines 30-44), and all other limitations have been addressed as set forth above.

Regarding claims 50-54, these are computer system versions of the claimed methods

discussed above (claims 40-44). *Berry et al.* further discloses the use of such systems/software

to implement the prescribed methods (*see, e.g., Berry et al.* at col. 14, lines 30-44), and all other

limitations have been addressed as set forth above.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JAMES RUTTEN whose telephone number is (571)272-3703.

The examiner can normally be reached on M-F 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Derek Rutten/
Primary Examiner, Art Unit 2192